The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS E. BROCKLEY and JAMES L. BROCKLEY

Appeal No. 2006-0770
Application No. 09/783,366
Technology Center 3600

Decided: July 31, 2006

Before OWENS, BAHR and FETTING, *Administrative Patent Judges.*

BAHR, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1, 5-9, 13, 17, 21-24, 28, 32 and 37-45, all of the claims pending in the application.

We AFFIRM.

BACKGROUND

The appellants' invention relates to a sports commemorator for storing a sports-related object. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relies upon the following as evidence of unpatentability:

Rand	405,678	Jun. 18, 1889
Feher	861,822	Jul. 30, 1907
Wilson	5,813,546	Sep. 29, 1998

The following rejection is before us for review.

Claims 1, 5-9, 13, 17, 21-24, 28, 32 and 37-45 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wilson in view of Feher and Rand.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding this appeal, we make reference to the examiner's final rejection (mailed October 24, 2003), first answer (mailed July 16, 2004) and substitute answer (mailed August 23, 2005) for the examiner's complete reasoning in support of the rejection and to the appellants' brief (filed April 26, 2004), first reply brief (filed September 17, 2004) and second reply brief (filed October 21, 2005) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the following determinations.

Although relying on the same evidence and statutory basis as in the final rejection, the examiner modified the explanation of the rejection slightly in the answer and then characterized the rejection as a new ground of rejection on page 6 of the first answer. Specifically, the examiner identified a second difference between Wilson and the appellants' claimed invention,

namely, the lack of the recited forward and rearward interfaces, in addition to the previously identified absence of a picture on the backing material. The appellant correctly pointed out on page 2 of the first reply brief that new grounds of rejection were not permitted in an examiner's answer under 37 CFR § 1.193(a)(2) in effect at the time the first answer was mailed but did not petition the new ground under 37 CFR § 1.181. In any event, the application was returned by the Board of Patent Appeals and Interferences to the examiner in an order mailed July 20, 2005 because the answer was defective for not stating the ground(s) of rejection therein. In the substitute answer, the examiner repeated the explanation of the rejection as stated in the first answer and positively stated the ground of rejection to be under 35 U.S.C. § 103 as being unpatentable over Wilson in view of Feher and Rand. At the time of the mailing of the second answer, 37 CFR § 41.39(a)(2), which now permits new grounds of rejection in an examiner's answer, was in effect.

Wilson discloses a cap display apparatus for displaying a cap having a bill connected to a collapsible crown, such as a baseball cap, the apparatus comprising a transparent plastic window piece 13 having a hollow form 15 portion and flat portions above and below the hollow form portion, the hollow form portion defining a cavity 31 for holding the cap 21 for display. A piece of backing material 33 made of conventional matting material provides a contrasting background for the cap, the display surface 35 of the backing material 33 contacting the rear surface of the window piece 13 such that the display surface shows through the front surface 16 of the window piece. A rigid back 39 contacts the backing material 33 and provides support and rigidity to both the window piece 13 and backing material 33. A rectangular frame 41 includes a semicircular front retaining edge 43 and a box-shaped rear retaining edge 45, spaced apart so that the window piece, backing material and rigid back are urged to remain in intimate contact with each other and are slightly compressed between the front retaining edge 43 and the rear retaining edge 45.

In light of the above description of Wilson's display apparatus, the semicircular front retaining edge 43 and the front face of the box-shaped rear retaining edge 45 respond fully to the

forward and rearward interfaces recited in claims 1 and 17. Accordingly, we conclude that the examiner's determination in the final rejection that the only difference between the subject matter of independent claims 1, 17 and 32 and Wilson resides in the picture on the layer recited in appellants' claims 1, 17 and 32 was a correct determination.

Claims 1, 17 and 32 each recite a picture on a layer, the picture illustrating a scene relating to said sports related object. The examiner relies on Rand for a suggestion to provide such a feature in the Wilson display apparatus. Rand discloses a display apparatus for preserving and displaying game comprising a frame A, a back B, and a glass cover C having a bulge C^2 to accommodate the stuffed game and other specimens of the taxidermist's art and a flange C^1 to fit into the frame between the glass cover and the back. Rand teaches that the back may be painted or otherwise provided with a picture for a pleasing background and illustrates in Figure 1 a scene giving the impression of the habitat of the game. A person of ordinary skill in the art of memorabilia display at the time of appellants' invention would have found in Rand a teaching to display objects to be preserved and commemorated within a display frame with a picture of the natural habitat or environment of the objects displayed on a surface behind the objects. This teaching would have provided such a person with ample suggestion to provide such a picture with other objects similarly displayed, such as the cap in the display apparatus of Wilson, to illustrate a scene or habitat associated with the object. We thus agree with the examiner that it would have been obvious to one of ordinary skill in the art to have provided a picture on or in an opening in the backing material 33 behind the cap displayed in Wilson's cap display apparatus, the picture illustrating a scene relating to the cap. With respect to claims 37-45, the specific details of such a scene do not affect the functioning of the device and are related merely to design considerations directed to printed matter that do not patentably distinguish the claimed subject matter from the prior art.

The appellants argue (first reply brief, p. 6) that Wilson's description of the backing material 33 providing a *contrasting* background for the cap 21 teaches away from the provision

of a picture of a scene on such backing material, as a scene would render the details of the cap less visible to an observer. This argument is not well founded as it is not apparent, and the appellants have not cogently explained, why the depiction of a scene behind the cap would necessarily have such an effect. A contrasting background need not be a solid color to permit the details of the cap to stand out to an observer.

The appellants also argue (first reply brief, p. 7) that it is not clear how a picture would be incorporated in the cap display apparatus device of Wilson since the cap itself occupies almost the entire display. With respect to this argument, we observe that all of the features of the secondary reference need not be bodily incorporated into the primary reference (*see In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)) and that the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgement (*Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984)). We also note that Wilson contemplates secondary displays behind the cap. The implication that one of ordinary skill in the field of commemorative displays would have been unable to make the necessary modifications with respect to positioning, dimensioning and relative scales, for example, to incorporate a picture of a scene into the display apparatus of Wilson such that it is not substantially obscured by the cap is untenable.

For the reasons discussed above, the appellants' arguments fall short in persuading us that the examiner has erred in rejecting claims 1, 17, 32 and 37-45 as being unpatentable over Wilson in view of Feher[1] and Rand. The rejection is sustained. The like rejection of dependent claims 5-9, 13, 21-24 and 28 is also sustained, as the appellants have not separately argued the rejection of these claims apart from claims 1, 17 and 32. (*see In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); *In re Wood*, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

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[1] The examiner's application of Feher is superfluous to the rejection of these claims but, in any event, has not been specifically challenged by the appellants.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 5-9, 13, 17, 21-24, 28, 32 and 37-45 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

TERRY J. OWENS
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

ANTON W. FETTING
Administrative Patent Judge

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